



[3510-16-P]

**DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

**37 CFR Part 42**

**[Docket No.: PTO-P-2015-0053]**

**RIN: 0651-AD01**

**Proposed Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board; Reopening of Period for Comments**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Notice of proposed rulemaking; reopening of comment period.

**SUMMARY:** The Leahy-Smith America Invents Act (AIA) provided for new administrative trial proceedings before the Patent Trial and Appeal Board (Board). The United States Patent and Trademark Office (USPTO) issued a number of final rules and a trial practice guide in August and September of 2012 to implement the new administrative trial provisions of the AIA. The USPTO published a request for comments in the Federal Register on June 27, 2014, seeking public comment on all aspects of the new administrative trial proceedings, including the administrative trial

proceeding rules and trial practice guide. In response to comments received by the public, the USPTO issued a first, final rule, which was published on May 19, 2015. That final rule addressed issues concerning the patent owner's motion to amend and the petitioner's reply brief that involved ministerial changes. The USPTO issued a second, proposed rule that addresses more involved proposed changes to the rules concerning the claim construction standard for AIA trials, new testimonial evidence submitted with a patent owner's preliminary response, Rule 11-type certification, and word count for major briefing. The USPTO is now extending the period for public comment on the second, proposed rule until November 18, 2015.

**DATES:** Written comments on the proposed rule published August 20, 2015 (80 FR 50720) must be received on or before November 18, 2015.

**ADDRESSES:** Comments must be sent by electronic mail message over the Internet addressed to: Trialrules2015@uspto.gov.

Electronic comments submitted in plain text are preferred, but also may be submitted in ADOBE® portable document format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format. The comments will be available for viewing via the USPTO's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection,

information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

**FOR FURTHER INFORMATION CONTACT:** Susan L. C. Mitchell, Lead Administrative Patent Judge by telephone at (571) 272-9797.

**SUPPLEMENTARY INFORMATION:** Sections 3, 6, and 18 of the AIA provided for the following new Board administrative trial proceedings: (1) inter partes review; (2) post-grant review; (3) covered business method patents review; and (4) derivation proceedings. Pub. L. 112–29, 125 Stat. 284 (2011). The USPTO issued a number of final rules and a trial practice guide in August and September of 2012 to implement the new administrative trial provisions of the AIA. See Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 FR 48612 (Aug. 14, 2012) (final rule); Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 FR 48680 (Aug. 14, 2012) (final rule); Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention, 77 FR 48734 (Aug. 14, 2012) (final rule); Changes to Implement Derivation Proceedings, 77 FR 56068 (Sept. 11, 2012) (final rule); and Office Patent Trial Practice Guide, 77 FR 48756 (Aug. 14, 2012).

In issuing the administrative trial proceeding rules and trial practice guide, the USPTO committed to revisiting the rules and practice guide once the Board and public had operated under the rules and practice guide for some period and had gained experience

with the new administrative trial proceedings. The USPTO began the process of revisiting the AIA administrative trial proceeding rules and trial practice guide by engaging in a nation-wide listening tour. The USPTO conducted a series of roundtables in April and May of 2014, held in Alexandria, New York City, Chicago, Detroit, Silicon Valley, Seattle, Dallas, and Denver, to share information concerning the AIA administrative trial proceedings with the public and obtain public feedback on these proceedings. The USPTO also published a request for comments in the Federal Register on June 27, 2014, seeking public comment on all aspects of the new administrative trial proceedings, including the administrative trial proceeding rules and trial practice guide. See Request for Comments on Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 79 FR 36474-77 (June 27, 2014). In response to comments received, the USPTO issued two rule packages: (1) a first, final rule package that addressed issues concerning the patent owner's motion to amend and the petitioner's reply brief that involved ministerial changes, see Amendments to the Rules of Practice for Trial Before the Patent Trial and Appeal Board, 80 FR 28561-66 (May 19, 2015), and (2) a second, proposed rule that addresses more involved proposed changes to the rules concerning the claim construction standard for AIA trials, new testimonial evidence submitted with a patent owner's preliminary response, Rule 11-type certification, and word count for major briefing, see Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 80 FR 50720-47 (Aug. 20, 2015). The notice of proposed rulemaking for the second, proposed rule indicated that written comments must be received on or before October 19, 2015. See id at 50720. In view of stakeholder requests for additional time to submit comments on the new administrative trial

proceedings, the USPTO is now extending the period for public comment until November 18, 2015.

Date: October 26, 2015 \_

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Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

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